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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,499	08/27/2001	Namita Surolia	IN99/00026	8616

7590  
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Boston, MA 02109

03/16/2006

EXAMINER
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WEDDINGTON, KEVIN E

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/763,499	<b>Applicant(s)</b> SUROLIA, NAMITA	
	<b>Examiner</b> Kevin E. Weddington	<b>Art Unit</b> 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 51-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51 and 55-62 is/are rejected.
- 7) ☒ Claim(s) 52-54 and 63 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2-17-06</u> . | 6) <input type="checkbox"/> Other: _____  |

Claims 51-63 are presented for examination.

Applicants' information disclosure statement and affidavit under 37 CFR 1.132 filed February 17, 2006 have been received and entered.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 17, 2006 has been entered.

***Claim Objections***

Claims 52-54 and 63 are objected to as being dependent upon a rejected base claim 51, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 51 and 55-62 are again rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating malaria caused by Plasmodium parasite, *P. falciparum* with hydroxydiphenyl ether compounds, does not reasonably provide enablement for other inhibitor of fatty acid synthesis; effective

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against the other three Plasmodium parasites that causes malaria, *P. vivax*, *P. ovale*, and *P. malariae* or the addition of another known antimalarial agents with the inhibitors of fatty acid synthesis. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

In this regard, the application disclosure and claims have been compared per factors indicated in the decision In re Wands, 8 USPQ2d 1400 (Fed. Cir., 1988) as to undue experimentation.

The factors include:

- 1) the quantity of experimentation necessary
- 2) the amount of direction or guidance provided
- 3) the presence or absence of working examples
- 4) the nature of the invention
- 5) the state of the art
- 6) the relative skill of those in the art
- 7) the predictability of the art and
- 8) the breadth of the claims

The instant specification fails to provide guidance that would allow the skilled artisan background sufficient to practice that instant invention without resorting to undue experimentation in view of further discussion below.

As of record, for reasons of record as set forth in the Office action dated August 15, 2005 at pages 2-6 as applied to claims 51-53 and 55-62.

Applicant's remarks regarding the instant specification does shows enablement for treating malaria caused by the other three Plasmodium parasites that causes malaria, *P. vivax*, *P. ovale*, and *P. malariae* are not persuasive since the applicant states in the response dated February 17, 2006 that the instant specification does shows data for treating malaria caused by *P. falciparum* (*Examples 1 and 2*) and *P. berghei*(*Example 3*). However, the claims do not recite this critical limitation.

Applicant's submitted affidavit under 132 shows that another inhibitor of fatty acid synthesis such as cerulenin, is effective in the inhibiting the growth of Plasmodium falciparum only and not the other three Plasmodium parasites. Also the affidavit does not show other inhibitors of fatty acid synthesis are effective in treating malaria.

Again, applicant's instant specification does not contain any experimental data showing the combination of the hydroxydiphenyl ether compounds or derivatives with other antimalarial agents as set forth in claims 55-57, 60 and 61.

The rejections made under 35 USC 112, first paragraph as adhered to.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin E. Weddington whose telephone number is (571)272-0587. The examiner can normally be reached on 11:00 am-7:30 pm.

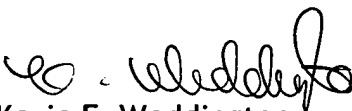
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571)272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Kevin E. Weddington". The signature is stylized with a large, looped "K" and a cursive "Weddington".

Kevin E. Weddington

Primary Examiner

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K. Weddington

March 13, 2006